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APPLICATION NO.	FILING DATE	FIRST-NAMED INVENTOR	ATTORNEY DOCKET NO.
08/953,154	10/17/97	KUZAK	430,154US1

MM51/0414
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EXAMINER
PATEL, J

ART UNIT	PAPER NUMBER
2835	

DATE MAILED: 04/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
08/953,154

Applicant(s)
Aith A. Kozak, Charles T. Dammon, Anton R. Pool

Examiner
JAGDISH PATEL

Group Art Unit
2835



☒ Responsive to communication(s) filed on Mar 18, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Oct 17, 1997 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "power source" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered

Claim 10, The keyboard of claim 1, further comprising "a power source" disposed within the housing.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 11-17, 19, 20, 24 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 1, the preamble is "A keyboard", it is noted that "a device" and "a computer" are inferentially recited. Any subsequent reference "the device" and "the computer" lacks proper antecedent basis.

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5. Claim 17, the preamble is "A keyboard", it is noted that "a personal digital assistant (PDA) device" and "a computer" are inferentially recited. Any subsequent reference "the personal digital assistant (PDA) device" and "the computer" lacks proper antecedent basis.

6. Claim 20, the preamble is "A keyboard", it is noted that "a device" and "a computer" are inferentially recited. Any subsequent reference "the device" and "the computer" lacks proper antecedent basis.

7. Claim 24, the preamble is "A device", it is noted that "a computer peripheral" is inferentially recited. Any subsequent reference "the computer peripheral" lacks proper antecedent basis.

8. Claims 12 and 19 contain the trademark/trade name U.S. Robotics Pilot. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe U.S. Robotics Pilot is trade name for Pilot PDA manufactured by U. S. Robotics available in commercial market and, accordingly, the identification/description is indefinite.

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Claim Rejections - 35 U.S.C. § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-8, 10-22 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson et al (US Patent # 4,762,435) in view of Applicant's admitted prior art (page 1, line 15-24 and page 2, line 1-9). Richardson discloses a keyboard 12 having a housing 12, a plurality of keys 33,37 disposed within the housing 12, a communication link 24, 25 disposed within the housing 12 to communicatively couple the keyboard to the computer 10, and a connector (the connector on the front of the communication link 24 and 25) not shown with number, 41 operatively coupled to the communication link 24,25, the connector disposed within the housing 12 and receptive to a corresponding connector of a device 14, 15, 11 such that the device 14, 15, 11 communicates with the computer 10 over the communication link when the connectors are coupled, the housing 12 has a plurality of the surfaces (fig 2) defining a cradle cavity 13,17,22 into which the connector is disposed (fig 2), the cradle cavity 13, 17, 22 shaped so that the device 14, 15, 11 fits into the cavity 13, 17, 22 such that at least one surface of the device 14, 15, 11 is exposed (fig 1), the cradle cavity is shaped so that the device fits into cavity such that at least front surface of the device 11,15,14 is exposed, the cradle cavity is shaped so

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that the device fits into the cavity such that at least top surface of the device 14, 15, 11 is exposed, the housing 12 has an end surface into which the connector is disposed, the connector of the device 14, 15, 11 coupling the connector of the housing 12 such that at least one of a top and a bottom surface of the device is flush with a corresponding surface of the housing (fig 1), the communication link 25, 24 having at least a cable (fig 2). Richardson does not teach specific device communicates with the computer over communication link when connectors are coupled. Applicant's disclose in the admitted prior art (page 1, line 15-24 and page 2, line 1-3) a modular device is Pilot PDA device with touch screen communicates with the computer over communication link when device is docked to the computer. Therefore, it would have been obvious to a person of the ordinary skill in the art at the time the invention was made to use a specific device as taught by Applicant's admitted prior art in place of the modular device of Richardson to provide better communication between the devices in interactive or on-line mode via communication link.

11. Claims 11-22 and 24-28, Richardson teaches devices connected to keyboard, it is noted that Richardson teaches the use of various devices mounted in cradle portions of the computer peripheral. Richardson lacks to teaches the specific device structure as claimed. Applicant's disclose in the admitted prior art (page 1, line 15-24 and page 2, line 1-3) a device is docked to the computer or being used remotely (page 2), and in specification (page 6, line 16-21) personal digital assistant device could be a U.S. Robotics Pilot, a telephone handset, a television remote control, etc., as well as other consumer electronics. Applicant's admitted prior art teaches a PDA

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device is U.S. Robotics pilot having a housing, a touch screen, a controller, a connector, a wireless transceiver, one changeable virtual key, power source, and docked into the computer and mounted in cradle. Therefore, it would have been obvious to one of ordinary skill in the art to mount any known and conventional electronic device in a cradle area with electrical connections in view of teachings of Richardson to provide various feature to the keyboard. There is no unobviousness in any of a number of devices being mounted in cradle portions as exemplified by the variety of known devices applicant lists in claim 16. While Applicant's admitted prior art does not discuss a computer keyboard and rechargeable battery, it is recognized that to provide such components are inherent or obvious in the design of the most PDA devices.

12. Regarding claims 7, Richardson lacks cable is a universal serial bus-compatible cable the universal serial bus-compatible cable used by applicant, however the examiner takes official notice as to the universal serial bus-compatible cable are conventional and well known in the communication art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time invention was made to use a conventional universal serial bus-compatible cable instead of cabling of Richardson for better communication between the devices.

13. Regarding claim 8, Richardson teaches the communication link including cable. Richardson lacks communication link including a radio frequency (RF) transceiver. Applicant's admitted prior art teaches device including a wireless transceiver communicate with computer in stand-alone mode, however the examiner takes official notice as to the types of the conventional data communication link such as a radio frequency, a cable-type arrangement or an infrared data

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link are well known in the communication art. Therefore, it would have been obvious to a person of ordinary skill in the art at the time invention was made to use a conventional radio frequency transceiver in the communication link of the Richardson to provide better communication between the devices in interactive or on-line mode via communication link.

14. Regarding claim 10, Richardson does not show the power source disposed within the keyboard housing, however the examiner takes official notice as to the power source disposed within the keyboard housing, it is recognized that the keyboard required a power from internal or external source to communicate with the corresponding devices, and to provide a power source to the keyboard are inherent or obvious in the design of the most keyboard operated devices. With respect to power source disposed with in the keyboard housing is a conventional and well known in the hand-held computer with keyboard, LCD screen with keyboard (for data input/output and functional operation with writing pad or touch pad) and wireless keyboard (work as a remote data input/output and function operating device for the computer) are available in commercial market, which is capable of operating from a self-contained power source such as a alkaline battery, rechargeable battery and solar power. Therefore, it would have been obvious to person of ordinary skill in the art at the time the invention was made to use a conventional and well known power source in the keyboard of Richardson to adding greater versatility to the keyboard.

15. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Richardson et al (US Patent # 4,762,435) in view of Applicant's admitted prior art (page 1, line 15-24 and page 2, line 1-9) as applied to claim 1 and 23 above, and further in

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view of Viletto (US Patent # 5,475,626). The combination of Richardson, Official notice and Applicant's admitted prior art does not show the keyboard housing including a recharger and rechargeable battery. Viletto teaches a computer system 31 including a display housing 33 and a keyboard housing 32, the keyboard housing including a rechargeable battery 88 and recharger 89 (describe in column 3, line 35-58, fig 3). Therefore, it would have been obvious to person of ordinary skill in the art at the time the invention was made to use a recharger and rechargeable battery in the keyboard housing of Richardson and Applicant's admitted prior art as taught by Viletto to provide more power option to the keyboard.

Response to Arguments

16. Applicant's arguments with respect to claim filed on March 18, 1999 have been considered but are moot in view of the new ground(s) of rejection.

17. Applicant's arguments with respect to *Claim Rejections - 35 USC § 112* filed on Mar 18, 1999 have been fully considered but they are not persuasive. Because, Applicant does not claim "a device" positively in the independent claim, but claims the device in a dependent claim.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ma, Tan, Friend et al, Wetterau Jr, Register, Bernard, Tomoda and Kapec et al disclose different type of keyboard housing.

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19. Any inquiry concerning this communication or earlier communications from the examiner Jagdish Patel should be directed to whose telephone number is (703) 305-0930. The examiner can normally be reached on "Monday-Thursday" from 7:00 am to 5:30 pm.

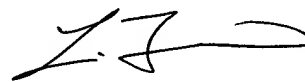
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard, can be reached on (703) 308-0538.



Jagdish Patel

Patent examiner

April 12, 1999



**LYNN D. FEILD
PRIMARY EXAMINER**